ATTACHMENT A
Remarks

In response to the Office Action mailed on August 16, 2004, reconsideration of the rejection of claims 1-24 is respectfully requested.

A. Rejection of Claims 1-2 and 4-8 Under 35 U.S.C. § 101

Claims 1-2 and 4-8 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter falling outside the technological arts.

Amended independent claim 1 is directed to a method for configuring a build-to-order system using an information appliance to access a browsing interface via a world wide network. Claims 2 and 4-8 depend from claim 1. Thus, claims 1-2 and 4-8 clearly fall within the "technological arts." Accordingly, it is respectfully suggested that the rejection of claims 1-2 and 4-8 under 35 U.S.C. § 101 can be properly withdrawn.

B. Rejection of Claims 8, 16 and 24 Under 35 U.S.C. § 112

Claims 8, 16 and 24 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that there is insufficient antecedent basis for the limitation "and comparison information regarding said selection and a product currently being utilized by a user" in claims 8, 16 and 24.

Amended claims 8, 16 and 24 no longer contain the limitation set forth above. Thus, it is respectfully suggested that the rejection of claims 8, 16 and 24 under 35 U.S.C. § 112, second paragraph, can be properly withdrawn.

Further, the attention of the Examiner is also directed to new claims 25-27, which contain the limitation set forth above supported by proper antecedent basis specifically provided in the new claims.

C. Rejection of Claims 1-4, 9-13 and 17-21 Under 35 U.S.C. § 102

Claims 1-4, 9-13 and 17-21 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Henson (U.S. Patent 6,167,383). This rejection is respectfully traversed.

Independent claims 1, 9 and 17 recite "receiving a system configuration selection including a combination of system elements" and "providing a description of a function capable of being implemented with said system configuration selection." Considering a non-limiting example of this aspect of the invention, FIG. 5A of the instant application shows a display of a build-to-order computer system according to one embodiment of the invention, wherein a lower end model of a printer and a lower end model of a digital camera have been selected. The "description of a function capable of being implemented with the system configuration selection" in this example is: "Take good quality pictures to e-mail to friends. Print color images at 1 page per minute." Further, FIG. 5B shows a display of an alternative system where the description of the function capable of being implemented with the system is: "Take high quality (2 mega pixel) pictures to e-mail to friends. Record 15 second video clips. Listen to music on your camera. Print photo quality color images at 10 pages per minute." Thus, as is believed evident from these two examples, a description is provided of a function capable of being implemented with the selected system configuration selection, including a combination of system elements.

The Examiner states that Henson teaches a method for configuring a build-to-order system including "providing a description of a function capable of being implemented with said system configuration selection." FIG. 3A, FIG. 5 and col. 9, ll. 9-25 are cited in support. FIG. 3A contains descriptions such as, "a larger hard drive provides more storage space for the operating system ..., monitors can deliver enhanced resolution and refresh rates, crisp, vibrant imaging and amazing color depth, etc..."

The Applicant respectfully disagrees with the characterization by the Examiner of Henson. Henson only teaches providing a description of functions capable of being implemented with individual system elements. For instance, the examples cited are directed to the hard drive ("a larger hard drive provides more storage space ...") and the monitor ("monitors can deliver enhanced resolution ..."). Nowhere does Henson teach or suggest providing a description of a function capable of being implemented with the system configuration selection, including a combination of system elements, such as "take good quality pictures and print at 1 page per minute" or "take high quality pictures, record video clips, listen to music on your camera, and print at 10 pages per minute," as claimed in independent claims 1, 9 and 17.

It is noted that new dependent claims 25, 27 and 29 have been added which depend, respectively, from claims 1, 9 and 17 and which specifically recite that the system configuration selection is a "selection of a particular configuration of system elements making up a particular system configuration" and that the description is thus "of a function of the particular system configuration rather than of a function of an

individual element of the particular system." Thus, I is respectfully submitted that new claims 25, 27 and 29 clearly define over Henson for these reasons as well.

Claims 2-4, 10-13 and 18-21 depend from claims 1, 9 and 17 and are thus patentable for at least the reasons set forth above in support of the patentability of the independent claims. Accordingly, it is respectfully suggests that the rejection of claims 1-4, 9-13 and 17-21 under 35 U.S.C. § 102(e) as being anticipated by Henson can be properly withdrawn. Further, new claims 25, 27 and 29 can be properly allowed.

D. Rejection of Claims 5-7, 13-15 and 21-23 Under 35 U.S.C. § 103

Claims 5-7, 13-15 and 21-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson in view of Tuzhilin (U.S. Patent 6,236,978). This rejection is respectfully traversed.

It is respectfully submitted that Tuzhilin fails to make up the deficiencies of Henson as a reference against the claims and, thus, that neither Henson nor Tuzhilin, however combined or taken together, teach or suggest providing a description of a function capable of being implemented with the system configuration selection. Accordingly, for at least the reasons discussed above, it is respectfully suggested that the rejection claims 5-7, 13-15 and 21-23 can also be properly withdrawn.

Further, even if Tuzhilin were viewed as making up the deficiencies of Henson as described above, it is noted that claims 7, 15 and 23 recite a personal history file including at least one of a list of browsed products and a current component configuration. Tuzhilin appears to teach gathering personal history information only by collecting completed transactional information or user entered information. This is not a teaching of the list of browsed products or current component configuration recited in

claims 7, 15 and 23. Thus, neither Henson nor Tuzhilin, viewed alone or together, teach or suggest a personal history file including a list of browsed products, or a current component configuration, as set forth in claims 7, 15 and 23. Thus, for these further reasons the rejection of claims 7, 15 and 23 can be properly withdrawn.

E. Rejection of Claims 8, 16 and 24 Under 35 U.S.C. § 103

Claims 8, 16 and 24 have been rejected under 35 U.S.C. § 103(a) as being obvious over Henson in view of Official Notice. This rejection is respectfully traversed.

Claims 8, 16 and 24 have been amended to remove the phrase "comparison information regarding the selection and a product currently being utilized by the user". It is also noted that newly added claims 26, 28 and 30 recite that the description includes "comparison information regarding the selection and the user's current products and components".

It is respectfully submitted that the Official Notice also fails to make up the deficiencies of Henson as a reference against the claims and, thus, that neither Henson nor the Official Notice, however combined or taken together, teach or suggest providing a description of a function capable of being implemented with the system configuration selection. Accordingly, for at least the reasons discussed above, it is respectfully suggested that the rejection claims 8, 16 and 24 can also be properly withdrawn and new claims 26, 28 and 30 can also be allowed.

If the rejection of claims 8, 16 and 24 under 35 U.S.C. § 103(a) is not withdrawn for the reasons described above, the Applicant respectfully requests that, in accordance with the provisions of MPEP 2144.03, the Examiner produce authority for the Official Notice. It is noted that of the examples provided, i.e., a computer system, a TV, and a

camera, neither the TV nor the camera are traditionally multi-component or build-to-order systems such as are the subjects of the instant invention. Further, computers are generally not marketed as build-to-order systems in stores which have sales persons and which are physically visited by customers, where an exchange between the customer and sales person with regard to the components of the customer's current product takes place. In this regard, it is noted that most customers are probably not aware of all of the details of the individual components of their current products that would enable such an exchange to take place, even if such stores did exist.

F. Prior Art Made of Record and Not Relied On

The prior art made of record but not relied on in the instant Office Action has been reviewed. However, none of the references appears to be any more relevant than the references discussed herein. Thus, further discussion of the additional references does not appear warranted at this time.

Conclusion

It is respectfully urged that the instant application, as amended, is now in condition for allowance. However, if the Examiner believes that there are unresolved issues, the Examiner is respectfully invited to contact Applicant's attorney to discuss these issues.

END REMARKS